

### **REMARKS**

Claim 12 has been amended herein. Claims 20-45 have been added. Claims 1-45 are now pending in the Application. Support for the amendment is found in the Specification, original claims, and drawings. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

### **Rejections Pursuant To 35 U.S.C. § 112**

In the Action, claims 1-19 were rejected pursuant to 35 U.S.C. § 112, second paragraph. It was asserted in the Action that claims 1-19 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Action further asserts that the items missing from the claims that are in the Specification include a touch screen. This rejection is respectfully traversed.

Applicant's Specification on page 57, lines 3-9 includes the following:

"In alternative embodiments of the invention multiple browsers may be operated in the computer(s) of the ATM for purposes of processing instructions in documents. Some browsers may operate to process instructions and may not provide outputs that may be perceived by users of the machine. Such browsers may be operated to provide instructions that are used for operating transaction function devices. For example, a browser which does not produce an output which is visible on a display, may process documents which produce outputs that are operative to cause a printer to produce printed documents."

The Specification further discloses that: "Other embodiments may operate multiple browsers which provide outputs which can be perceived by customers operating the machine."

Thus although embodiments of the invention may include an output device such as a touch screen (30), nowhere in the Specification is it disclosed that all embodiments of the invention require a touch screen. It is respectfully submitted that claims 1-19 particularly point out and distinctly claim the subject matter which Applicants regard as the invention. On this basis, claims 1-19 satisfy the requirements of 35 U.S.C. § 112, second paragraph.

### **Claim Objections**

It was indicated in the Action that claims 13-18 were objected to for referencing steps using letters in parenthesis which have no precedent in prior claims. The prior claim 12 has been amended herein to correct this typographical error. The method steps recited in amended claim 12 now include labels with letters in parenthesis as referenced by the dependent claims 13-18. It is respectfully submitted that the objection to claims 13-18 have been obviated by the amendment to claim 12.

### **The Pending Claims Are Not Obvious in View of the Applied Art**

Claims 1, 2, 3, 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta, U.S. Patent No. 5,619,558 and Bertram et al., U.S. Patent No. 6,049,812 ("Bertram").

Claims 4, 5 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta and Bertram as applied to claims 1 and 12 and further in view of Sigona, et al. U.S. Patent No. 5,694,150 ("Sigona").

Claims 6-9, 14 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta and Bertram as applied to claims 1 and 12 and further in view of Murphy, Jr. et al. U.S. Patent No. 6,049,820 ("Murphy").

Claims 10, 15 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta and Bertram as applied to claims 9, 12 and 13 and further in view of Cleron, et al. U.S. Patent No. 5,724,506 ("Cleron").

These rejections are respectfully traversed.

**The Applied References Do Not Disclose or Suggest  
the Features and Relationships Recited in Applicants' Claims**

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

#### **The Jheeta Reference**

Jheeta is directed to an ATM that is operative to dispense to a customer a receipt containing a transaction record, a promotion, and a telephone number for redeeming the promotion by the customer.

#### **The Bertram Reference**

Bertram is directed to a single browser that is operative to maintain multiple, concurrently active URLs within "marked tabs" (13) (Figure 4).

#### **The Sigona Reference**

Sigona is directed to a multiple screen display driver system which provides a multi-user environment on displayed portions of a large virtual image space.

### **The Murphy Reference**

Murphy is directed to an Internet system having a plurality of applications, a plurality of servers, and a plurality of client computers, each with a browser.

### **The Cleron Reference**

Cleron is directed to a connection dialog component that enables a user to specify address information of a particular resource coupled to a computer network. Cleron discloses windows of a graphical user interface which include user interface elements which enable a user to manipulate the size and appearance of the windows (Column 3, lines 60-65).

### **The Pending Claims Are Not Obvious Over Jheeta and Bertram**

In the Action claims 1, 2, 3, 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta and Bertram. These rejections are respectfully traversed. Applicants response to these rejections is based on the Office's referenced interpretations of Jheeta and Bertram. Thus, any change in the Office's interpretation of these references shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

### Claim 1

Claim 1 is an independent claim which is specifically directed to an apparatus which comprises an automated banking machine. The automated banking machine includes a computer and at least one transaction function device in operative connection with the computer. The automated banking machine further includes a plurality of browsers operating in the computer. The computer is operative to cause the transaction function device to operate responsive to instructions in at least one document processed by at least one of the browsers.

With regard to claim 1 the Action asserts that Jheeta discloses an automated banking machine including a computer and at least one transaction function device in operative connection with the computer. The Action also asserts that Bertram discloses a plurality of browsers operating in a computer. The Action also asserts that Bertram discloses that the computer is operative to cause the transaction function device to operate responsive to instructions in at least one document processed by at least one of the browsers.

Applicants disagree. Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness.

Bertram discloses a single browser that is operative to maintain multiple, concurrently active URLs associated with "marked tabs." Bertram does not disclose or suggest an automated banking machine. Further Bertram does not disclose or suggest an automated banking machine with transaction function devices. Although Jheeta discloses an ATM, neither Jheeta nor Bertram discloses or suggests an automated banking machine that includes a plurality of browsers operating in the computer of the automated banking machine. Further neither reference

includes any suggestion, teaching or motivation to modify the ATM of Jheeta to include one or more browsers.

In addition neither Jheeta nor Bertram alone or in combination discloses or suggests a computer in an automated banking machine that is operative to cause a transaction function device to operate responsive to instructions in at least one document. In addition neither reference alone or in combination discloses or suggests a computer that is operative to cause the transaction function device to operate responsive to instructions in at least one document processed by at least one of the browsers of the automated banking machine. Further neither reference includes any suggestion, teaching or motivation to modify the ATM of Jheeta to operate transaction functions devices responsive to instructions in a document processed by a browser.

Because the Action has failed to show that all of the elements and relationships recited in the claims are known in the prior art, the Office has not met its burden of establishing prima facie obviousness. Further, even if all of the features recited in the claim could have been found in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. The Action has also failed to clearly and particularly identify a teaching, suggestion, or motivation to combine the features in the prior art references of Jheeta and Bertram to support a rejection on the basis of obviousness.

As nothing in the cited art discloses or suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is

respectfully submitted that claim 1 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that claims 2-11, and 21 which depend from claim 1 are likewise allowable.

### **Claim 12**

Claim 12 is an independent method claim. The method comprises: a) operating a plurality of browsers in a computer in operative connection with an automated banking machine; b) operating a transaction function device in the banking machine responsive to at least one document processed by at least one of the browsers; and c) delivering outputs through at least one output device in connection with the automated banking machine responsive to documents processed by at least two of the browsers.

As discussed previously with respect to claim 1 neither Jheeta nor Bertram discloses or suggests operating a plurality of browsers in a computer in operative connection with an automated banking machine. Further neither references discloses or suggests operating a transaction function device in the banking machine responsive to at least one document processed by at least one of the browsers. In addition, neither reference discloses or suggests delivering outputs through at least one output device in connection with the automated banking machine responsive to documents processed by at least two of the browsers.

As nothing in the cited art discloses or suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that claim 12 is allowable for these reasons. Therefore, it is respectfully

submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that claims 13-20 which depend from claim 12 are likewise allowable.

### **Claim 2**

Claim 2 depends from claim 1 and recites that the automated banking machine further comprises at least one output device in operative connection with the computer. Documents processed by at least two of the browsers produce outputs delivered simultaneously through the output device.

Neither Jheeta nor Bertram discloses or suggests an automated banking machine which includes a browser operating in a computer of the automated banking machine. Further, neither reference discloses or suggests an automated banking machine which includes a plurality of browsers operating in a computer of the automated banking machine. In addition, neither reference discloses or suggests documents processed by at least two of the browsers which produce outputs delivered simultaneously through an output device of the automated banking machine. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 2 is further allowable on this basis.

### **Claim 3**

Claim 3 depends from claim 2 and recites that the output device includes a display. Claim 3 also recites that each of the two browsers outputs on separate portions of the display.

Neither Jheeta nor Bertram discloses or suggests that each of two browsers of an automated banking machine outputs on separate portions of a display device of the automated

banking machine. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 3 is further allowable on this basis.

#### **Claim 11**

Claim 11 depends from claim 1 and recites that the at least one document includes an HTML document.

As admitted in the Action Jheeta fails to disclose an HTML document. In addition although Bertram discloses a browser that is operative to access HTML documents, neither Jheeta nor Bertram disclose or suggest an HTML document that is processed by at least one browser of an automated banking machine. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 11 is further allowable on this basis.

#### **Claim 13**

Claim 13 depends from claim 12 and recites that the automated banking machine includes a display device. In addition claim 13 recites that in step (c) outputs from at least two of the browsers are output through the display device.

Neither Jheeta nor Bertram discloses or suggests outputs from at least two browsers that are output through a display device of an automated banking machine. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 13 is further allowable on this basis.

### **Claim 19**

Claim 19 depends from claim 12, and recites that at least one output is delivered through at least one output device responsive to at least one HTML document processed by at least one of the browsers.

As admitted in the Action Jheeta fails to disclose an HTML document. In addition although Bertram discloses a browser that is operative to access HTML documents, neither Jheeta nor Bertram disclose or suggest that an output is delivered through at least one output device of an automated banking machine responsive to at least one HTML document processed by at least one browser of the automated banking machine. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 19 is further allowable on this basis.

### **The Pending Claims Are Not Obvious Over Jheeta and Bertram in view of Sigona**

In the Action claims 4, 5 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta and Bertram as applied to claims 1 and 12 and further in view of Sigona. These rejections are respectfully traversed. Applicants response to these rejections is based on the Office's referenced interpretations of Jheeta, Bertram, and Sigona. Thus, any change in the Office's interpretation of these references shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is

no teaching, suggestion or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

#### **Claims 4 and 17**

Claim 4 depends from claim 1 and recites that the transaction function device is operated responsive to documents processed by a plurality of browsers. Claim 17 depends from claim 12 and recites that in step (b) a transaction function device is operated responsive to documents processed by a plurality of the browsers.

Neither Jheeta nor Bertram disclose or suggest a transaction function device that is operated responsive to documents processed by a plurality of browsers. In addition, it is respectfully submitted that Sigona does not disclose or suggest the features recited in claim 4 that are missing from Jheeta and Bertram. Sigona discloses a multiple screen display driver system which provides a multi-user environment on displayed portions of a large virtual image space. Sigona does not disclose or suggest transaction function devices of an automated banking machine. Further Sigona does not disclose or suggest a browser that is operative to process documents. In addition Sigona does not disclose a transaction function device that is operative responsive to documents processed by a plurality of browsers. As nothing in the applied art discloses or suggests these features, it is respectfully submitted that claims 4 and 17 are further allowable on this basis.

### **Claim 5**

Claim 5 depends from claim 1, and recites that the automated banking machine includes a card reader in operative connection with the computer. The computer is operative to include card data read by the card reader in a transaction data object. Instructions in documents processed by a plurality of the browsers are operative to access the card data from the transaction data object.

Although Sigona discloses a system with multiple display devices, Sigona does not disclose or suggest documents processed by a plurality of the browsers as asserted in the Action. Also, neither Jheeta, Bertram, nor Sigona discloses or suggests instructions in documents processed by a plurality of browsers which are operative to access card data included in a transaction data object. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 5 is further allowable on this basis.

### **The Pending Claims Are Not Obvious Over Jheeta and Bertram in view of Murphy**

In the Action claims 6, 7, 8, 9, 14 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta and Bertram as applied to claims 1 and 12 and further in view of Murphy. These rejections are respectfully traversed. Applicants response to these rejections is based on the Office's referenced interpretations of Jheeta, Bertram, and Murphy. Thus, any change in the Office's interpretation of these references shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is

no teaching, suggestion or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

#### **Claim 6**

Claim 6 depends from claim 1 and further comprises a network and a plurality of servers in operative connection with the network. The computer of the automated banking machine is in operative connection with the network. Claim 1 further recites that a first server is operative to deliver first documents and a second server is operative to deliver second documents. A first browser operating in the banking machine is operative to process the first documents from the first server and a second browser operating in the banking machine is operative to process the second documents from the second server.

Murphy is directed to an Internet system having a plurality of applications, a plurality of servers, and a plurality of client computers, each with a browser. Neither Jheeta, Bertram nor Murphy disclose or suggest a first browser operating in the banking machine which is operative to process first documents from a first server and a second browser operating in the banking machine which is operative to process second documents from a second server.

In addition, neither Bertram nor Murphy discloses or suggests an automated banking machine. Further none of the cited references includes a teaching, suggestion or motivation to modify Jheeta to include first and second browsers operating in an automated banking machine. In addition none of the cited references includes a teaching, suggestion or motivation to modify Jheeta to include a first browser operating in the banking machine which is operative to process first documents from a first server and to include a second browser operating in the banking

machine which is operative to process second documents from a second server. As nothing in the applied art discloses or suggests these features, it is respectfully submitted that claim 6 is further allowable on this basis.

### **Claims 7 and 18**

Claim 7 depends from claim 6 and recites that the automated banking machine includes a display device in operative connection with the computer. At least one of the first and second browsers is operative to cause a visible output through the display device.

Claim 18 depends from claim 12 and recites that the automated banking machine includes a display device. In step (a) at least five browsers are operated in the machine. In step (c) outputs corresponding to documents processed by each of the five browsers are delivered through the display device.

Neither Jheeta, Bertram, nor Murphy disclose or suggest an automated banking machine with first and second browsers or with at least five browsers. Further neither Jheeta, Bertram, nor Murphy disclose or suggest an automated banking machine in which at least one of the first and second browsers is operative to cause a visible output through a display device of the automated banking machine. Further neither Jheeta, Bertram, nor Murphy disclose or suggest outputs corresponding to documents processed by each of five browsers which are delivered through the display device of the automated banking machine. As nothing in the applied art discloses or suggests these features, it is respectfully submitted that claims 7 and 18 are further allowable on this basis.

### **Claim 8**

Claim 8 depends from claim 6 and recites that at least one of the browsers is operative to produce a non-visible output. The non-visible output is operative to cause the computer to control operation of at least one transaction function device in the banking machine.

Bertram does not disclose or suggest controlling the operation of at least one transaction function device in an automated banking machine with a non-visible output produced with a browser. Further neither Jheeta, Bertram, nor Murphy alone or in combination disclose or suggest a non-visible output produced by at least one browser that is operative to cause the computer of an automated banking machine to control operation of at least one transaction function device in the automated banking machine.

As nothing in the applied art discloses or suggests these features, it is respectfully submitted that claim 8 is further allowable on this basis.

### **Claims 9 and 14**

Claim 9 depends from claim 7 and recites that at least one of the first documents includes at least one show instruction. The computer is operative responsive to the show instruction to cause a further visible output responsive to the second browser to be output through the display device.

Claim 14 depends from claim 12 and recites that at least one document includes a show instruction. Prior to step (c) the method further comprises the step of reading the show

instruction with a first browser. In step (c) an output responsive to a second browser is delivered responsive to reading the show instruction.

Neither, Jheeta, Bertram, nor Murphy disclose or suggest a computer that is operative responsive to a show instruction in a first document processed by a first browser to cause a further visible output to be output through a display device of the automated banking machine responsive to a second browser.

Further, neither Jheeta, Bertram, nor Murphy disclose or suggest reading a show instruction in a first document with a first browser and responsive to reading the show instruction, delivering an output to an output device of an automated banking machine responsive to a second browser.

As nothing in the applied art discloses or suggests these features, it is respectfully submitted that claims 9 and 14 are further allowable on this basis.

**The Pending Claims Are Not Obvious Over  
Jheeta and Bertram in view of Cleron**

In the Action claims 10, 15 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta and Bertram as applied to claims 9, 12 and 13 and further in view of Cleron. These rejections are respectfully traversed. Applicants response to these rejections is based on the Office's referenced interpretations of Jheeta, Bertram, and Cleron. Thus, any change in the Office's interpretation of these references shall constitute a new ground of rejection.

In addition Applicants traverse these rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and

because there is no teaching, suggestion or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

### **Claim 10**

Claim 10 depends from claim 9 and recites that at least one of the first documents includes at least one size instruction. The computer is operative responsive to the size instruction to size the further visible output.

In the Action, base claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta, Bertram, and Murphy. Also in the Action it was admitted that Jheeta and Bertram do not include all of the elements recited in the base claim 9. However, in the Action claim 10 which depends from claim 9 was not rejected as being unpatentable in view of Murphy.

To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. The Action has failed to show where all of the admitted missing elements recited in the base claim 9 are found in the Cleron reference. Thus *prima facie* obviousness has not been established with respect to dependent claim 10.

In addition, contrary to the assertion made in the Action, Cleron does not disclose or suggest a document that includes a size instruction. Rather Cleron discloses windows of a graphical user interface which includes user interface elements which enable a user to manipulate the size and appearance of the windows (Column 3, lines 60-65).

Neither Jheeta, Bertram, nor Cleron discloses or suggests that at least one of the first documents includes at least one size instruction. Further neither reference discloses or suggests

that the computer of the automated banking machine is operative responsive to the size instruction to size the further visible output.

As nothing in the applied art discloses or suggests these features, it is respectfully submitted that claim 10 is further allowable on this basis.

### **Claim 15**

Claim 15 depends from claim 12 and recites that at least one document includes a size instruction. In addition the method further comprises the step of reading the size instruction with a first browser. In step (c) an output responsive to a second browser is produced having a magnitude responsive to the size instruction.

As discussed previously with respect to claim 10, Cleron does not disclose or suggest a document that includes a size instruction as alleged. Neither Jheeta, Bertram, nor Cleron disclose or suggest that at least one document includes a size instruction. Further neither reference discloses or suggests the step of reading the size instruction with a first browser. In addition neither reference discloses or suggests an output responsive to a second browser that is produced having a magnitude responsive to the size instruction.

As nothing in the applied art discloses or suggests these features, it is respectfully submitted that claim 15 is further allowable on this basis.

### **Claim 16**

Claim 16 depends from claim 13 and recites that in step (c) a size of at least one output from a browser is determined responsive to other outputs.

Neither Jheeta, Bertram, nor Cleron disclose or suggest that a size of at least one output from a browser is determined responsive to other outputs.

As nothing in the applied art discloses or suggests this features, it is respectfully submitted that claim 16 is further allowable on this basis.

### **The New Claims**

None of the cited references alone or in combination discloses or suggests the features and relationships that are specifically recited in the new claims 19-45. These claims recite features, relationships and steps recited in the original claims and are allowable for at least the same reasons. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that the new claims are allowable for these reasons.

### **Additional Comments**

Applicants also request acknowledgment of their claim for domestic priority under 35 U.S.C. § 119(e). This Application claims the benefit of U.S. Provisional Application Serial No. 60/144,761 filed July 20, 1999.

### **Additional Claim Fees**

Please charge the fees associated with prosecution of two additional independent claims in excess of three ( \$168) and twenty-five additional total claims (\$450) and any other fee due, to Deposit Account No. 09-0428 of InterBold.

### Conclusion

Each of Applicants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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